

hydroxyl group density no greater than about 3 hydroxyl groups per nm², it contends that it would have been obvious to a worker of ordinary skill in the art to use the silica powder taught in Kaneko et al. in a polishing composition disclosed by Adams et al.

Applicants respectfully traverse this rejection because the references themselves fail to provide an adequate basis for the asserted combination, and thus cannot be combined to render the subject claims unpatentable.

Specifically, Adams et al. is directed to an apparatus for use in chemical-mechanical polishing that includes a system for recycling the polishing composition. In marked contrast, Kaneko et al. is directed to a process for producing a ceramic perform comprising (i) mixing a fine silica powder with an alkoxy silane in alcohol solvent, (ii) molding the mixture, and (iii) heating the mold to dealcoholize the mixture. Clearly, the references address completely different subject matters (i.e., a CMP apparatus *versus* a process for producing ceramic materials). This significant difference militates against the combination of their disclosures. In fact, this significant difference suggests that the only means by which the asserted combination of references can be supported is by hindsight, using the subject claims as a guide to "piece together" the prior art. The use of hindsight in this manner, however, is improper.

There is nothing in Kaneko et al. which would have taught one of ordinary skill in the art that fine silica powders having low surface hydroxyl group density would be particularly useful in a method of chemical-mechanical polishing. Moreover, there is no suggestion in either reference (as there must be) that one skilled in the art could readily apply the teachings pertaining to a process for forming ceramic articles in a method of chemical-mechanical polishing with the expectation of achieving a desired result.

In view of the foregoing, the obviousness rejection of the pending claims over the combination of Adams et al. and Kaneko et al. should be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Date: February 28, 2002

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date: February 28, 2002

